

## **REMARKS**

Claims 1-3, 5-9 and 11-18 are pending in this application. Claim 10 has been canceled in this paper and Claims 4 and 19-26 were canceled in previous papers submitted to the Office in this case. Claims 1, 5-8 and 14 have been amended to define still more clearly what Applicants regard as their invention. Applicants note that in the Office Action Summary, Claims 19-26 were listed as pending claims, and in the Detailed Action, Claims 19-26 were rejected. Since Claims 19-26 were canceled in the paper dated March 14, 2005, submitted to the Office, Applicants will not address any rejections directed to Claims 19-26. Claim 1 is in independent form. Favorable reconsideration is requested.

### **Double Patenting Objection**

The Office Action objected to Claim 10 under 37 C.F.R. § 1.75 as being a substantial duplicate of Claim 9. As stated above, Applicants have canceled Claim 10 thereby rendering this provisional objection moot. Applicants respectfully request withdrawal of this objection.

### **35 U.S.C. § 112 Rejections**

The Office Action rejected Claims 5, 6 and 14 under 35 U.S.C. § 112, second paragraph, for insufficient antecedent basis of some of the claims' recitations. Applicants have amended Claim 5, at line 3, and Claim 6, at line 4, to change "the cross-sectional dimension" to --a cross-sectional dimension--, and have amended Claim 14, at line 3, to change "said guiding web" to --said at least one guiding web--. Applicants believe the Section 112 rejections have been overcome and hereby request withdrawal of these rejections.

### **35 U.S.C. §§ 102 and 103 Rejections**

The Office Action rejected Claims 1-3, 5-12 and 14-18 under 35 U.S.C. § 102(b) as being anticipated by Japanese Patent No. JP 11-157290 to Kobayashi ("Kobayashi") and rejected Claims 1-3 and 5-18 under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi in view of U.S. Patent No. 5,772,840 (Morinaga) and U.S. Patent No. 5,462,633 (Manusch et al.). Applicants respectfully traverse these rejections.

Applicants respectfully submit that amended independent claim 1, together with the remaining claims dependent thereon, is patentably distinct from Kobayashi for at least the following reasons.

The aspect of the present invention set forth in Claim 1 is a hand-held device for transferring a film from a backing tape onto a substrate. The device includes a housing in which a supply of the backing tape is arranged. The device also includes an application member projecting from the housing and having a front end with a free end and at least a first application edge and a second application edge, the backing tape being wound around the free end and the application edges of the application member and extending into the housing with tape sections at a lower longitudinal side of the application member facing the substrate during operation and at an upper longitudinal side of the application member opposite the lower longitudinal side. The second application edge projects from the lower longitudinal side of the application member, and the first application edge and the second application edge are linear.

Among other notable features of Claim 1 is that the first application edge and the second application edge are linear. Support in the specification for this feature can be found in the drawings, at least, for example, in Figures 1-4, 6 and 8. An advantage of having linear edges on the first and second application members is that a user can control the application of the correction tape from the device onto the paper.

Kobayashi, as understood by Applicants, relates to a transfer utensil that uses a first press section 15 at a nose of a cam of the plate-like material 17 and a second press section 16 in the flat-surface portion of the plate-like material 17 to apply correction tape to paper (see Kobayashi, paragraph [0019]). When the Kobayashi device is used in the standing position (see, e.g., Fig. 5), the first press section 15 at the nose of the cam of the plate-like material is made to contact the paper and correction tape having a width of the first press section is imprinted on the paper. In Kobayashi, however, the second press section 16 has a spherical shape that Applicants submit, make using the Kobayashi device more difficult to use because a user will not be able to control the application of the correction tape from the spherical member 16 onto the paper. For example, in use, if the spherical member 16 is tilted in one direction, the contact point between the spherical member 16 and the paper will change thus making it more difficult for the user to control the application of the correction tape. In fact, due to the shape of the spherical member the user will not even be able to see the application of the tape thereby causing further problems in applying the correction tape to the paper. In addition, if a user tilts the spherical member 16 too much, the guiding web 18 will contact the paper and no correction tape will be applied to the paper.

Accordingly, Applicants submit that at least for the reasons described above, Claim 1 is patentable over Kobayashi et al., and consequently Applicants hereby request withdrawal of this rejection.

A review of the other art of record including Morinaga and Manusch et al. has failed to reveal anything that, in Applicants' opinion, would remedy the deficiencies of the art discussed above, as applied against independent Claim 1 herein. Therefore, Claim 1 is respectfully submitted to be patentable over the art of record.

The other rejected claims in this application depend from Claim 1 discussed above, and, therefore, are submitted to be patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, individual reconsideration of the patentability of each claim on its own merits is respectfully requested.

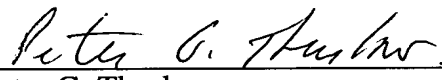
### CONCLUSION

Applicants respectfully submit that the present claims are now in condition for allowance and request an early issuance of a Notice of Allowance in connection with the present application. If the Examiner wishes to discuss this case, then Applicants respectfully request a personal or telephonic interview to discuss any remaining issues and expedite the allowance of the application.

No fee is believed to be due for this amendment. In the event a fee is required, please charge the required fee to Jones Day Deposit Account No. 50-3013.

Respectfully submitted,

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